

## REMARKS/ARGUMENTS

The election/restriction requirement dated June 6, 2008 has been considered. The Examiner contends that the claims are drawn to four inventions, namely Group I (Claims 1-14, 23); Group II (Claims 15-22, 24, 25); Group III (Claims 32-37); and Group IV (Claims 26-31, 38-40) and asserts that restriction to one of claim Groups I-IV is required under 35 U.S.C. §121. The Applicants respectfully traverse the restriction requirement.

The claims of **Group IV (Claims 26-31, 38-40)** are provisionally elected with traverse. The Applicants traverse the requirement as failing to satisfy the requirements for maintaining such a restriction requirement. The Applicants request reconsideration and withdrawal of the restriction requirement.

In paragraph 3 of the Official Action, it is alleged that the claims grouped into Groups I-IV are related as subcombinations disclosed as usable together in a single combination, which is governed by M.P.E.P. § 806.05(c). M.P.E.P. § 806.05(c) requires, among other things, establishing the following: 1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and 2) the subcombination has utility either by itself or in another materially different combination. Without acquiescing to the particular reasons for restriction between Groups I and III as required under M.P.E.P. § 806.05(c), the Applicants note that, in order to establish reasons for insisting upon restriction, the Examiner must also explain why there would be a serious burden on the Examiner if restriction is not required. (MPEP § 808.02).

With respect to the above-stated requirements, it is respectfully submitted that the single, disclosed *combination* to which the subcombinations are usable together has not been identified. In order to establish that the alleged subcombinations have “utility other than in the disclosed combination” (MPEP §806.05(d)), the Examiner must first identify such a combination. Such a combination has not been identified in the restriction requirement, and therefore it is not possible to establish that the identified subcombinations have a differing utility than the combination. Thus, the restriction requirement fails to show that one of the subcombinations has utility other than in the disclosed combination. Because there has been no showing of what the “disclosed *combination*” is that the Examiner is relying on, Applicant is not afforded an opportunity to provide a reasoned response. For this reason, Applicant

requests withdrawal of the requirement for election/restriction, or further clarification pursuant to MPEP § 806.05(d).

Regarding Groups I, III, and IV, Applicant submits that what is set forth as evidence of “separate utility” merely recites selected limitations from selected independent claims of Group I, III, and IV. However, the Examiner has not shown that these limitations result in the alleged subcombinations of Groups I, III, and IV being separately usable from any disclosed combination. Applicant respectfully submits that the mere difference in language of a claim from the language of another claim does not establish that either of the alleged subcombinations have utility other than some combination, notwithstanding that the combination has not been properly identified.

Regarding Group II, the Examiner contends on page 2 of the Office Action that “Claims 15-22, 24, 25, are drawn to, ‘search engine couple to Web Server to gather tagged content with a mobile terminal containing a text to speech module to convert textual portions of the Web content into audible information.’ classified in claim 379, subclass 56.2” (emphasis in original). A “text to speech module” was also cited in paragraph 3 of the Office Action to support the contention that Group II has separate utility than Groups I, III, and IV. However, Applicants note that only dependent Claims 20 and 22 of Group II recite a text to speech module. Therefore, inasmuch as the Examiner is relying on recitations of a text-to-speech module to support the restriction requirement, such language can only be used to support the restriction of Claims 20 and 22 of Group II that recite these features. As a result, the Applicants submit that there has been no reasoning presented to support the restriction of at least Claims 15-19, 21, 24, and 25, thus the restriction is improper because there has been no showing that Claims 15-19, 21, 24, and 25 have separately utility from the claims of Groups I, III, and IV.

Further, the restriction requirement does not establish that there is no overlap in scope between the asserted subcombinations, and Applicant respectfully submits that there is overlap in scope to the extent that restriction is improper. For example, many of the claim limitations may represent overlap in scope, but this has not been established in the Office Action. For at least this additional reason, the restriction requirement is improper for failure to meet the burden for requiring restriction.

Finally, Applicant notes that in order to establish reasons for insisting upon restriction, the Examiner must explain why there would be a serious burden on the Examiner if restriction is not required. If the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions. MPEP §808.02. This requirement has not been satisfied for at least the claims of Groups III and IV, as these claims are shown to be classified in the same class, class 715. The Examiner has at least not shown why a serious burden would be incurred when each of the asserted groups of claims is classified substantially together.

Applicants, in traversing the Examiner's Restriction Requirement, is directing its arguments to the limited issue of the lack of proper grounds supporting the restriction of Applicants' claims for examination purposes. As such, Applicants' characterization of the claimed subject matter as it may pertain to the issue of distinctiveness or lack thereof within the context of restriction practice is not to be construed as an admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. § 103.

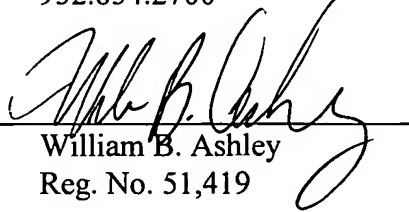
In view of the above, the Applicant respectfully requests reconsideration and withdrawal of the restriction requirement to the claims of alleged Groups I-IV. If the Examiner would find it helpful to discuss this issue by telephone, the undersigned attorney of record invites the Examiner to contact the attorney of record.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC  
8009 34th Avenue South, Suite 125  
Minneapolis, MN 55425  
952.854.2700

Date: July 10, 2008

By:

  
William B. Ashley  
Reg. No. 51,419